

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, in FIGS. 2 and 3, and in the specification as originally filed, for example, on page 7, lines 1-10, and on page 7, line 17 through page 8, line 17. As such, no new matter has been introduced.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1, 2, 4, 5, 9-11, 13-15, 18 and 20 under 35 U.S.C. §102(e) as being anticipated by Au (U.S. Patent No. 6,646,578) is respectfully traversed and should be withdrawn.

The Federal Circuit has stated: "A claim is anticipated only if **each and every element** as set forth in the claim is found, either **expressly or inherently** described, in a single prior art reference."¹ "The elements must be **arranged as required by the**

¹ Manual of Patent Examining Procedure (M.P.E.P.), Eighth Edition, Rev. 5, August 2006, §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, USPQ2d 1051, 1053 (Fed Circ. 1987) (emphasis added).

claim.² The Federal circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."³ As explained herein below, because the Office Action does not identify where each and every element as set forth in the presently pending claims is found in Au, the Office Action does not meet the Office's burden to factually establish a *prima facie* case that Au anticipates the claimed invention.

The presently claimed invention (claim 1) provides a method for decoding a bitstream, comprising the steps of: (A) generating a first signal and a second signal by parsing a common slice in the bitstream, (B) generating a third signal by entropy decoding the first signal and (C) generating a video signal by combining the second signal and the third signal. Claims 9 and 13 recite similar limitations. With respect to the presently claimed first signal and second signal, the Office Action cites column 11, lines 5-10 of Au (see page 3, lines 6-11 of the Office Action). The cited portion of Au refers to FIG. 3 of Au and states:

² M.P.E.P. §2131 citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added).

³ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

The incoming video bitstream 15 is stored in the buffer 500 at the input to the decoder 20. The first stage in the decoding process includes the parsing and decoding of the entropy coded bitstream 15 symbols that are stored in the buffer 500 to produce the syntax elements 503 used by the other decoder components (column 11, lines 5-10 of Au).

The cited portion of Au does not refer to a first signal and a second signal, as presently claimed. Specifically, Au states that the syntax elements 503 result from parsing AND DECODING the entropy coded bitstream 15 symbols. Since the syntax elements 503 are obtain by decoding, it follows that the syntax elements 503 would not be considered to be the same as either the first signal or the second signal as presently claimed. Furthermore, the Office Action does not explain why, as viewed by a person of ordinary skill in the field of the invention, there is no difference between the reference disclosure and the claimed invention as required by the Federal Circuit. As such, the rejection does not appear to be sustainable and should be withdrawn.

Furthermore, FIG. 3 of Au shows a single signal coming from the buffer 500 and going to the entropy decoder 503. Assuming, *arguendo*, the output 512 of the entropy decoder 20 in FIG. 3 of Au would be considered similar to the presently claimed third signal, Au also does not appear to disclose generating a video signal by combining a signal parsed from the bitstream 15 prior to entropy decoding (e.g., similar to the presently claimed second signal) and the output 512 of the entropy decoder 20. As

such, the rejection does not appear to be sustainable and should be withdrawn.

Claim 2 provides accepting the common slice containing a plurality of macroblocks, where the plurality of macroblocks switch from non-I_PCM mode macroblocks to I_PCM mode macroblocks in macroblock scan order. The Office Action states that Au fails to disclose the use of pulse code modulation (see page 10, line 8 of the Office Action). As such, claim 2 is fully patentable over Au and the rejection should be withdrawn.

With respect to claim 14, the Office Action does not address the specific limitations of the claim, arranged as in claim 14. Specifically, the Office Action states:

Au discloses a method for encoding a bitstream (Au: column 11, lines 10-32), comprising the steps of: (A) generating a first signal and a second signal by parsing (Au: column 8, lines 65-67; column 9, lines 1-10) a common slice in said bitstream (Au: column 8, lines 35-40); generating a third signal by entropy encoding said first signal (Au: column 10, lines 5-20); and generating a video signal by combining said second signal and said third signal (Au: column 10, lines 60-67), as in claim 14 (see page 4, lines 12-17 of the Office Action).

In contrast to the Office Action, claim 14 provides a method for encoding **a video signal**, comprising the steps of: (A) generating a first signal and a second signal by parsing **said video signal**, (B) generating a third signal by entropy encoding said first signal and (C) generating **a bitstream** by combining said second signal and said third signal **within a common slice**. The Office Action clearly does

not address the specific limitations of claim 14, arranged as in claim 14. As such, the rejection does not appear to be sustainable and should be withdrawn.

Claims 2-8, 10-12 and 15-24 depend, directly or indirectly, from either claim 1, claim 9 or claim 14 which are believed to be allowable. As such, the rejection does not appear to be sustainable and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 3, 6-8, 12, 16, 17, 19 and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Au in view of Marpe et al. (U.S. Patent No. 6,894,628; hereinafter Marpe) is respectfully traversed and should be withdrawn.

An Applicant may overcome a 35 U.S.C. §103 rejection based on a combination of references by showing completion of the invention by the Applicant prior to the effective date of any of the references (MPEP §715.02(I)). The Applicant need not antedate the reference with the earliest filing date (MPEP §715.02(I)). The Applicant may antedate a reference by providing evidence of prior conception of the invention coupled with reasonable diligence beginning prior to the effective reference date until either an actual reduction to practice of the invention or the filing of the patent application (see 37 CFR 1.131(b)). Proof of reasonable diligence does not require the inventor to work constantly on the

invention or to drop all other work (*Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001), reh'g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986)).

The earliest effective priority date of Marpe is July 17, 2003. In particular, Marpe has a filing date of July 17, 2003 (see Marpe at page 1, item (22)). The present invention was conceived prior to July 17, 2003, the earliest effective priority date of Marpe. Specifically, on June 29, 2007, Applicants submitted a Response After Final which included a Declaration under 37 CFR §1.131 accompanied by exhibits showing conception of the present invention prior to May 28, 2003 (see the Response After Final and Declaration under 37 CFR §1.131 filed June 29, 2007, entered by the Examiner on August 2, 2007). In particular, the present invention was conceived prior to May 28, 2003 (see paragraph no. 5 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131). May 28, 2003 is clearly earlier than July 17, 2003 (the earliest effective priority date of Marpe). Therefore, the earliest effective filing date of Marpe is after the conception of the present invention.

The Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and the associated Exhibits A-F provides evidence of the prior conception and diligence up to the filing

date (i.e., July 22, 2003) of the present application (see paragraph nos. 5-13 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131). Specifically, the LSI Invention Disclosure Form, drawings and figures in Exhibit A clearly provide demonstrative evidence of the conception of the present invention. In particular, paragraph 5 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 specifically refers to the material in Exhibit A as showing the conception of the claimed invention.

Furthermore, paragraph no. 7 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 states that there is a direct correspondence between the diagrams and figures in Exhibit A and the figures of the presently pending application. Specifically, FIGS. 2-5 of the present application correspond to the Diagrams #1 and #2 and Figures #3 and #4 on pages 5-9 of Exhibit A.

Furthermore, the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 further states that the pages 1-4 of the LSI Invention Disclosure Form in Exhibit A show an original document date which was before May 28, 2003. Paragraph no. 8 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 states that the material in Exhibit A was submitted to LSI's legal department prior to May 28, 2003. The fact that the dates have been redacted does not alter the document's ability to

evidence that the conception of the presently claimed invention occurred prior to May 28, 2003 (see MPEP §715.07 II ESTABLISHMENT OF DATES). Thus, the attached Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and the associated Exhibits A-F provide evidence of (i) the conception of the present invention prior to the earliest effective date of the Marpe reference and (ii) diligence up to the filing date (i.e., July 22, 2003) of the present application (see paragraph nos. 5-13 of the Declaration of Lowell L. Winger and Eric C. Pearson under 37 CFR §1.131 and Exhibits A-F). Therefore, Marpe is not available as prior art against the claims. As such, the rejection based upon the combination of Au and Marpe does not appear to be sustainable should be withdrawn.

Claims 2-8, 10-12 and 15-24 depend, directly or indirectly, from either claim 1, claim 9 or claim 14 which are believed to be allowable. As such, the rejection does not appear to be sustainable and should be withdrawn.

New claims 25 and 26 depend directly from either claim 1 or claim 9 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references.

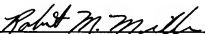
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative between 9 a.m. and 5 p.m. ET at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

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LSI Corporation

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